

REMARKS

This is in response to the Office Action mailed September 8, 2004. New claims 21-42 are added. Formal drawings are submitted herewith. Applicant respectfully requests reconsideration of the rejections based on the following arguments.

I. **Claims Rejected Under 35 USC §102(e)**

The Examiner rejected claims 1-20 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,343,327 (“Daniels”). To anticipate a claim, every element of the claim must be disclosed within a single reference. Applicant respectfully traverses these rejections.

A. Independent claims 1, 11, 21-24 and 41 recite in part, “a plurality of lists of mailing addresses.”

For this feature of Applicant’s claims, the cited portion of Daniels relied upon by the Examiner states that “electronic inserter 110 splits the electronic delivery print stream 224 into individual electronic mail pieces and packages them with an insert appropriate for the electronic delivery mechanism specified for the electronic mail pieces.” Daniels, col. 5, lines 48-55 (emphasis added). Daniels defines a mail piece as including a document, electronic mail data instructions, and insert instructions. Daniels, Fig. 4 and accompanying text. Thus, the cited text does not discloses lists of any kind, much less lists of mailing addresses.

Accordingly, independent claims 1, 11, 21-24 and 41 are not anticipated by Daniels. As such, the claims which depend upon claims 1, 11, 21-24 and 41 (i.e., claims 2-10, 12-20, 25-40 and 42) are not anticipated by Daniels for at least the reasons given in connection with the claims from which they depend.

B. Independent claims 1, 11, 21-23 recite in part, “providing separate ones of the plurality of lists or groups of the plurality of lists to the plurality of electronic mail delivery resources.”

The relied upon portion of Daniels states that “[e]ach electronic mail piece is placed on a server executing message router 112, which may be a separate server from the mail server upon

which the electronic inserter 110 is executed.” Daniels, col. 6, lines 59-62. Again, Daniels is discussing the distribution of individual “mail pieces,” not lists of mail addresses.

Accordingly, independent claims 1, 11 and 21-23 are not anticipated by Daniels. As such, the claims which depend upon claims 1, 11 and 21-23 (i.e., claims 2-10, 12-20, 31-36 and 37-40) are not anticipated by Daniels for at least the reasons given in connection with the claims from which they depend.

C. *Independent claims 1, 11, 21-24 and 41 recite in part, “the plurality of electronic mail delivery resources are capable of processing separate ones of the plurality of lists in parallel.”*

An advantage of having a plurality of lists of mailing addresses is that it allows the lists to be distributed to separate electronic mail delivery resources which can operate in parallel. Parallel mail delivery can reduce the overall time it takes to send mail to a given number of destinations. In contrast, Daniels discloses a single electronic mail delivery component connected to output server 113. Daniels, Figure 1.

Accordingly, independent claims 1, 11, 21-24 and 41 are not anticipated by Daniels. As such, the claims which depend upon claims 1, 11, 21-24 and 41 (i.e., claims 2-10, 12-20, 25-40 and 42) are not anticipated by Daniels for at least the reasons given in connection with the claims from which they depend.

D. *Independent claims 1, 11, 21-24 and 41 recite in part, “transmitting the electronic mail messages with the plurality of electronic mail delivery resources.”*

As stated above, an advantage of having a plurality of electronic mail delivery resources is that it allows for performing mail delivery in parallel. But Daniels does not disclose parallel delivery of mail. In contrast to this feature of Applicant’s claims, Daniels teaches that “[m]essage router 112 sends the electronic mail piece to an output server subsystem 113 (shown in Fig. 1) for actual delivery.” Daniels, col. 7, lines 4-9. Output server 113 then provides the mail piece to a single e-mail delivery component. Daniels, Figure 1. Accordingly, Daniels does not teach a plurality of electronic mail delivery resources.

Accordingly, independent claims 1, 11, 21-24 and 41 are not anticipated by Daniels. As such, the claims which depend upon claims 1, 11, 21-24 and 41 (i.e., claims 2-10, 12-20, 25-40 and 42) are not anticipated by Daniels for at least the reasons given in connection with the claims from which they depend.

E. Claims 24, 32 and 40 recite in part, “the number of electronic mail transmission resources is estimated to satisfy a target delivery time.”

Again, Daniels does not disclose a plurality of electronic mail transmission resources. It follows that Daniels does not teach or suggest determining a number resources that can operate in parallel to satisfy a target delivery time.

Accordingly, independent claims 24, 32 and 40 are not anticipated by Daniels. Claims 25-30 depend from claim 24 and, as such, are not anticipated for at least the reason given in connection with claim 24.

F. Claims 5 and 15 recite in part, “partitioning the primary mailing list into the plurality of lists of mailing addresses.”

As argued above, Daniels discloses partitioning a document stream into separate “mail pieces,” not mailing addresses. Daniels also discloses a print stream processor 102 that generates an electronic mail run data file 222 which contains electronic delivery information. Daniels, Fig. 3 and accompanying text. Assuming for argument’s sake that data file 222 is analogous to the primary mailing list in Applicant’s claims (which it is not), Daniels fails to disclose partitioning it into separate lists of mailing addresses.

Accordingly, claims 5 and 15 are not anticipated by Daniels for this reason.

G. Claims 6 and 16 disclose in part, one or more bounced mail resources capable of receiving bounced messages.

Daniels discloses that if an electronic mail piece is not delivered after a certain length of time, the message router 112 generates and sends a “failed to process” or “failed to deliver” message to status/regeneration processor 118. Daniels, col. 4, lines 26-34. Unlike Applicant’s

claims, Daniels does not disclose receiving bounced messages or replies. Rather, “[t]he system may be configured to wait for a preset amount of time, e.g., four days, for the recipient to access the web page where the electronic mail piece was delivered. If the recipient has not accessed the web page in the preset amount of time, the electronic mail piece is considered not delivered.” Daniels, col. 7, lines 9-13. Thus, the status/regeneration processor 118 in Daniels receives notice when the time for access of a web page has expired, not when a message has bounced.

Furthermore, Daniels does not designate separate bounced mail resources for handling failed delivery attempts. Instead, router 112 must perform both message transmission *and* handle delivery errors for each message. Consequently, router 112 can potentially become a bottleneck. In contrast to Daniels, Applicant’s claims 6 and 12 recite a scalable system that offloads error processing which allows electronic mail transmission servers to devote more of their bandwidth to delivering messages.

Accordingly, claims 6 and 16 are not anticipated by Daniels for at least these reasons.

H. Claims 19 and 26 disclose in part, automatically updating the primary mailing list when mail delivery fails.

Daniels does not disclose this feature of Applicant’s claims. In contrast, the system in Daniels attempts to resend failed messages using alternative paths rather than deleting the destination address from a primary mailing list. Daniels, col. 7, lines 40-63.

II. Conclusion

Applicants' claims are not anticipated by Daniels for at least the reasons given above.

Should the Examiner have any questions or comments with reference to this Response, a telephone call to the undersigned attorney is invited. A prompt examination and allowance of the present application is solicited.

Respectfully submitted,

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